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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,246	01/18/2001	Jonathan Lowther	INTL-0510-US (P10479)	8160

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TROP PRUNER & HU, PC
8554 KATY FREEWAY
SUITE 100
HOUSTON, TX 77024

EXAMINER

DEMICO, MATTHEW R

ART UNIT PAPER NUMBER

2611

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,246

Applicant(s)

LOWTHERT ET AL.

Examiner

Matthew R Demicco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 11/01/2004. Claims 1-28 and 30-32 are pending. Claims 1-4, 11, 20-21 and 30 are amended. Claim 29 is canceled. Claims 31-32 are new. The objections to the specification and drawings are withdrawn in light of the amendment.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 11 and 21 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 9-11, 18-19 and 21-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9-11 and 19-22 of copending Application No. 09/764,748. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations.

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Claim 1 of the instant application corresponds to Claim 1 of the '246 application.

Claim 1 differs in that it collects information about a characteristic of a receiver and provides the information to a remote system to select a subset of advertising from a database for use with the receiver. This is an obvious variation because collecting information, reporting the information to a remote system and selecting an ad from a database based on the information is well known in the art as disclosed by U.S. Patent No. 6,029,045 to Picco et al. Such a modification is desirable in order to increase revenue from advertisers by presenting ads to a user that relate to programming and products they are most likely to be interested in and subsequently purchase.

Claims 9-10 of the instant application correspond to Claims 9-10 of the '748 application.

Claim 11 of the instant application corresponds to Claim 11 of the '748 application. Claim 11 differs in the same manner as Claim 1 above.

Claims 18-19 of the instant application correspond to Claims 19-20 of the '748 application.

Claim 21 of the instant application corresponds to Claim 21 of the '748 application. Claim 21 differs in the same manner as Claim 1 above.

Claim 22 of the instant application corresponds to Claim 22 of the '748 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-28 and 30-32 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,029,045 to Picco et al.

Regarding Claim 1, Picco discloses a method comprising allowing the use of content (Col. 4, Lines 51-54) on a content receiver (See Figure 4 and Col. 5, Lines 10-16), collecting information about a characteristic of the receiver (Col. 6, Lines 34-37, Col. 10, Lines 58-62 and Col. 11, Lines 9-13) and providing that information to a remove processor-based system (Col. 7, Lines 6-26). The information is used to select, from an advertising database (Col. 6, Line 57 - Col. 7, Line 6), an advertising subset that is based on the characteristic of the receiver (Col. 7, Lines 28-32). The receiver receives the advertising subset and selectively chooses ads from the subset for storage (Col. 7, Lines 35-61 and Col. 8, Lines 7-16) and automatically interrupts the use of content to temporarily replace the content with an advertisement (Col. 6, Lines 23-31 and Col. 8, Lines 19-39).

Regarding Claim 2, Picco discloses a method as stated above in Claim 1, wherein the set top box is operable to update content (Col. 7, Lines 35-48) by storing selected local content as stated above, including overwriting or removing selected content (Col.

10, Line 62- Col. 11, Line 1). This reads on the claimed combining the advertising subset with advertising available on the receiver.

Regarding Claim 3, Picco discloses a method as stated above in Claim 1, wherein collecting information includes monitoring the activities of the user of the receiver (Col. 11, Lines 9-13).

Regarding Claim 4, Picco discloses a method as stated above in Claim 3, wherein collecting information includes accumulating the collected data (Col. 11, Lines 9-13). This accumulation of user data reads on the claimed developing a database of information about activities undertaken by the user of the receiver.

Regarding Claim 5, Picco discloses a method as stated above in Claim 4, wherein advertisements are stored in a remote database and a subset of these ads are broadcast to user terminals for selective storage based on user profile information as stated above. This reads on the claimed selecting advertisements stored on the remote processor-based system (ads from the head-end's database) based on information about the user of the receiver (user profile).

Regarding Claim 6, Picco discloses a method as stated above in Claim 5, wherein advertisements available on the remote processor based system are broadcast to the terminals for storage as stated above. This reads on the claimed accessing of advertisements available on the remote processor-based system. It is inherent that the user's terminal must in some way catalog the data it has stored order to manage and retrieve the data (Col. 10, Lines 62-67). This reads on the claimed compiling a local electronic guide (catalog of files) to advertising resources by accessing (receiving and

storing) advertisements available on the remote processor-based system (head-end database of advertisements).

Regarding Claim 7, Picco discloses a method as stated above in Claim 1, wherein the advertising has associated an associated content profile, which is compared to the user's profile for storage and playback (Col. 7, Line 55 – Col. 8, Line 22). This reads on the claimed determining a characteristic of advertising and comparing it to information about the use of the receiver.

Regarding Claim 8, Picco discloses a method as stated above in Claim 1, wherein a user is operable to select television signals from satellite broadcasting for watching (Col. 5, Lines 10-16). The watching of satellite television signal reads on the claimed enabling a variety of content to be selected for play at any time.

Regarding Claims 9 and 10, Picco discloses a method as stated above in Claim 1, wherein content has an expiration date (Col. 6, Lines 61-67) and a maximum number of times it may be viewed (Col. 7, Lines 1-2). Further, the terminal may remove or overwrite content (Col. 10, Line 62 – Col. 11, Line 1). This reads on the claimed automatically replacing (overwriting) the content with advertising after allowing content to be used for a predetermined amount of time (date or number of views). This further reads on the claimed automatic determination at predetermined times whether to replace the content.

Regarding Claim 11, see Claim 1 above.

Regarding Claims 12-19, see Claims 8, 3-7 and 9-10 respectively.

Regarding Claim 20, Picco discloses an article as stated above in Claim 11, further storing instructions that enable to receiver to catalog the advertisements it has stored as stated above. This reads on the claimed automatically compiling a receiver-based database of advertising.

Regarding Claim 21, see Claim 1 above. It is inherent that such a computer-based terminal must run programming in order to function. This reads on the claimed shell.

Regarding Claim 22, Picco discloses a method as stated above in Claim 21, wherein the system is a television receiver (Col. 5, Lines 12-16).

Regarding Claims 23-28, see Claims 9-10, 8, 3-4 and 6 above, respectively.

Regarding Claim 30, see Claim 6 above.

Regarding Claim 31, see Claim 28 above.

Regarding Claim 32, see Claim 28 above. Further, it is implicit that such television-based advertising must be in one or more known languages. This reads on the claimed advertisements specialized for a particular language.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (571) 272-7293.

The examiner can normally be reached on Mon-Fri, 9am - 5pm.

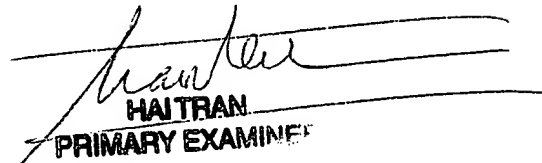
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MPP

mrd

April 8, 2005


HAI TRAN
PRIMARY EXAMINER